

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

Paper No. 28

Serial Number: 08/325,549  
Filing Date: 10/18/94  
Appellant(s): Barberg

Todd A. Rathe  
For Appellant

EXAMINER'S ANSWER

**MAILED**  
MAY 10 1996  
**GROUP 3500**

This is in response to appellant's brief on appeal filed  
December 13, 1996.

**(3) Status of Claims**

The statement of the status of the claims contained in the  
brief is correct.

**(4) Status of Amendments After Final**

The appellant's statement of the status of amendments after  
final rejection contained in the brief is correct. It should be  
noted that the After Final amendment of 12/11/95 has been  
entered.

Art Unit: 3503

**(5) *Summary of Invention***

The summary of invention contained in the brief is correct.

**(6) *Issues***

The appellant's statement of the issues in the brief is correct.

**(7) *Grouping of Claims***

Appellant's brief includes a statement that claims 1, 16-19, 22, 24, 26, 33, 34, 36, and 37 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

**(8) *Claims Appealed***

A substantially correct copy of appealed claim 18 appears on page 32 of the Appendix to the appellant's brief. The errors are as follows: on line 4, --, and a handle coupled to the sidewall-- should be inserted after "sidewall" and on line 18, "and the round bottom plate retain" should be only --retains--.

**(9) *Prior Art of Record***

The following is a listing of the prior art of record relied upon in the rejection of claims under appeal.

4,244,536      Harrill      1-1981

Serial Number: 08/325,549

-3-

Art Unit: 3503

4,015,795      Chong      4-1977

It should be noted that Schwartz, which was used in the Final Rejection, is no longer needed due to the deletion of the entire next-to-last paragraph of claim 1 in the After Final amendment of 10/13/95.

**(10) New Prior Art**

No new prior art has been applied in this examiner's answer.

**(11) Grounds of Rejection**

The drawings are objected to under 37 C.F.R. § 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the handle of claim 18 must be shown or the feature cancelled from the claims. No new matter should be entered.

Claims 18, 19, 22, 24, 26, 33, and 34 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A few examples are cited below; **all claims** should be revised carefully to correct other similar deficiencies.

For clarity and definiteness, it appears that --of-- should be inserted after "exterior" (claims 33, line 1)

Art Unit: 3503

The claims reciting the following **functions** lack recitation of sufficient structures/elements and/or necessary structural cooperation between the structures/elements to enable the functions to be effected: "retains the elongate flexible member concentrically ... column" (claim 18, lines 18-20) (it is not clear how the top or bottom plate can perform the recited function), "extends ... through the second access hole" (claim 22, line 3) (it is not clear how the second hole is positioned relative to the cavity).

In claim 18, line 7, "for freely resting" appears to be an incomplete phrase.

Claims 1, 16 and 17 are rejected under 35 U.S.C. § 103 as being unpatentable over Harrill in view of Chong.

Harrill discloses a container/housing 12 with a "base" 18 and having a rotatably mounted spool 10 having substantially all the claimed features including a first access hole 70 and a second access hole shown in Fig. 2. The spool 10 is comprised of sections 28 and 30 secured together by screws 90. A screw 54 rotatably attaches the spool 10 to the housing 12. It should be noted that central portion 20 is also a "base" of the container and the portion of the spool supported on the central portion is also a "bottom" of the spool. What is not disclosed is the foot plate. Chong discloses a similar apparatus in which a spool

Art Unit: 3503

comprising a bottom 26 is rotatably supported on a ball bearing assembly 28 ("bearing means") inside a bucket 16. A hole 22 is provided in the sidewall for dispensing the wound material. It does not appear that the spool is attached to the container. Note the "foot plate" 10. It would have been obvious to a person having ordinary skill in the art to provide the apparatus of Harrill with a foot plate as taught by Chong to support and stabilize the device and to extend the foot plate beyond the sidewall to increase stability or as a matter of ornamental design choice. The "means for retaining" of claim 17 reads on the cylindrical sidewall of the container 12 of Harrill. It would also have been obvious to a person having ordinary skill in the art to omit the screw 54 of Harrill so that the spool may be readily removed from the container as it is well established that omission of an element and its function where not needed is obvious and to provide the foot plate with mounting holes to facilitate mounting. The disposition of the mounting holes on the foot plate would have been an obvious matter of design choice to a person having ordinary skill in the art based on factors such as preference, space optimization, and costs.

Claims 18, 19, 22, 24, 26, 33, 34, 36, and 37 are rejected under 35 U.S.C. § 103 as being unpatentable over Chong in view of Harrill.

Serial Number: 08/325,549

-6-

Art Unit: 3503

Chong and Harrill have been advanced above. It would have been obvious to a person having ordinary skill in the art to alternatively provide the spool of Chong as the one taught by Harrill to facilitate removal/interchanging of the spool of material from the container and so that the inner end of the wound material is accessible such as for use as an extension cord and to provide the device of Chong with a handle as taught by Harrill (note handle 64) to facilitate manual handling such as for carrying purposes. It should be noted that, with the spool being unattached to the container, the edges of the top and bottom plates of both the spools of Harrill and Chong would engage the sidewall to concentrically and vertically retain the spool within the container during rotation (as claimed). It would have been obvious to a person having ordinary skill in the art to extend the length of the hole 22 of Chong as taught by the hole 70 of Harrill to facilitate dispensing of the wound material.

***(12) New Ground of Rejection***

This examiner's answer does not contain any new ground of rejection.

Art Unit: 3503

**(13) Response to argument**

1. Drawings objection

The handle is still recited in claim 18 contrary to appellant's assertion.

2. 35 USC 112, 2nd paragraph, rejection

The above rejection is deemed sufficiently clear. It is deemed that "for freely resting" is still deemed incomplete; the following is an example of a complete sentence: "The spool is freely resting on the base.". However, the above recitation in the claim is deemed an incomplete phrase and is deemed unclear even from the context.

3. The rejection on prior art

It should be noted that appellant's arguments are confusing because it is not clear which rejection appellant is arguing at any one time. For instance, claim 17 was rejected based on Harrill in view of Chong and not vice versa as is argued at the top half of page 18. Furthermore, appellant keeps referring to one sentence taken from the rejection of 02/07/95 (see Brief, page 19, last line). Appellant should note that the claims have been amended at least three times since that non-final action of 02/07/95 and that the Final rejection of 07/10/95 which apply to

Serial Number: 08/325,549

-8-

Art Unit: 3503

the appealed claims should instead be used as a base for arguments, not the action of 02/07/95.

It should be noted that statements of or arguments regarding intended use such as whether the apparatus of Harrill sits on "base" 18 or on portions 66 during use, the manner in which the apparatus is carried, the method of use of either Chong or Harrill, carry little or no patentable weight in an apparatus claim. The apparatus of Harrill can function equally well when the "base" 18 sits on a support surface as when it is supported on portions 66 and 68.

Appellant's general allegation of hindsight is insufficient and not persuasive because the Examiner has clearly pointed out the motivation in the reference and/or has provided a line of reasoning as to why a person having ordinary skill in the art would have found the modification obvious. The discussion of obviousness in the rejections above are incorporated by reference.

From a best understanding of the disclosure of Chong, the spool 26 of Chong is not attached to the container 16. However, even if it is attached to the container, it has been well established by case law that omission of an element and its function where not needed is obvious; therefore omission of any attaching means between the spool and the container would have been obvious to a person having ordinary skill in the art to



Serial Number: 08/325,549

-9-

Art Unit: 3503

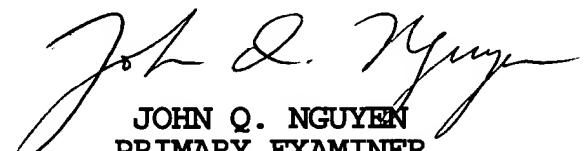
obtain a non-attached and readily removable spool for purposes such as for replacement, repair, and maintenance.

Is it appellant's contention that only appellant has recognized that "the bucket, the spool, and the elongate flexible member often require cleaning and conditioning" (page 23)? Even if this was true, the claims are only directed to an apparatus and such statement of intended use carry little or no patentable weight in apparatus claims.

Contrary to appellant's assertion, claims 18, 19, 22, 24, 26, 33, 34, 36, and 37 are not rejected upon the teachings of Harrill, Chong, and Schwartz.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

  
JOHN Q. NGUYEN  
PRIMARY EXAMINER  
GROUP 3500

JN

April 25, 1996

Kinney & Lange, P.A.  
Suite 1500  
625 Fourth Avenue South  
Minneapolis, MN 55415-1659